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Examiner Name	Jonathan R. Miller		
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Peter Bretschneider
Rudolf Schuster

Serial No.: 10/070,824

Filing Date: 03/11/2002

For: Device and Method for Classifying
Flat Mail Items

On Appeal to the Board of
Appeals and Interferences

Examiner: Jonathan R. Miller

Art Unit: 3653

Confirmation No: 2878

Client Ref.: 1999P02721WOUS

BRIEF ON APPEAL

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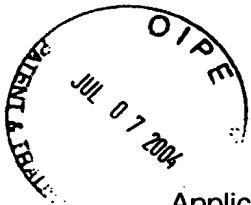
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BRIEF ON APPEAL

This Brief is timely filed in support of Applicant's Notice of Appeal which was received in the United States Patent and Trademark Office on July 8, 2002 (37 C.F.R. §1.192(a)).

I. REAL PART IN INTEREST

The real part in interest is Siemens Aktiengesellschaft.

II. RELATED APPEALS AND INTERFERENCES

The Applicants and the Applicants' legal representative, and the real party in interest are not aware of any appeals or interferences which will directly effect or be directly effected by or have a bearing on the Board's decision on the pending appeal.

III. STATUS OF CLAIMS

On March 11, 2002, Applicants' filed the present application with claims 1-18. A preliminary amendment was included with the first filing canceling claims 1-18 and introducing claims 19-27. In an Office Action dated October 4, 2003, the Examiner rejected claims 19-27. On December 16, 2003, Applicant amended claims 19-27. In an Office Action

dated February 12, 2004, the Examiner issued a final rejection of claims 19-27 as amended. No subsequent amendment was filed by Applicants.

III. STATUS OF AMENDMENTS

The preliminary amendment dated March 11, 2002 and the amendment to the claims dated December 16, 2003 were entered during prosecution by the Examiner. No other amendments to the claims have been filed.

V. SUMMARY OF THE INVENTION

Independent claims 19 and 24 define an arrangement and process for sorting mail items. The mail items arrive at the present invention grouped by destination area. The present invention will effect a fine sorting of the mail items by order of destination addresses within the destination area. The mail item groups themselves are sorted individually and sequentially. Interruptions, typically required for unloading output receptacles, are obviated. Accordingly, throughput is increased while mail piece fine sorting is effected (page 3, lines 6-32). The instant arrangement and process will be set out with general reference to figures 1-8 in the Specification and the detailed disclosure relating thereto on pages 6-15 as well as specific page and line citations.

In the instant arrangement, mail items are received pre-grouped. The mail items are introduced into containers 1, 4. The containers are accommodated upon a track about which they circulate (direction indicated by an arrow in figures 1 and 2). The containers comprise hollow bodies into which mail items 3 are introduced. A plurality of output receptacles 2 are positioned below the containers 1, 4 and are sized to receive one or more mail items introduced from the containers (page 6, lines 8-16). The mail items are sorted into select output receptacles according to the order of destination address delivery within the destination area of the mail item group. The output receptacles 2 are divided into two relatively equal sets so as to receive successive mail item groups. Accordingly, one set may

be emptied while another receives a subsequent mail item group. Therefore, one set is always available to receive a subsequent mail item group (page 9, line 5 – page 10, line 9).

The instant process comprises steps implemented by the above arrangement to effect select fine sorting schemes of sequentially incoming mail item groups. The destination addresses and order of delivery are known before the mail item group is introduced into the containers 1, 4. As the mail items of a first group are introduced into the containers, the individual mail item destination address' and receiving container are noted (page 6, line 23 – page 7, line 11 and page 8, lines 5-11). If, during introduction, it is determined that more than one mail item for one destination address is present, the respective mail items may be doubled up in one container. When the mail items are deposited into the output receptacles, the deposit is made in mail item delivery order. In other words, the mail items are sorted into the output receptacles. Accordingly, the resulting mail item stacks within the output receptacles are in delivery order (page 7, line 19-29).

Uninterrupted mail item handling and sorting is made possible by the division of the output receptacles into two relatively equal sets. As a result, different schemes for handling successive mail item groups are available. The schemes will be set out below with reference to their respective figures (page 10, lines 10-19).

In figure 4, a first mail item group is introduced into the containers. The first mail item group is then sorted into a first output receptacle set. A second mail item group (address area 2) is then introduced into the containers. Then, the first output receptacle set is emptied relatively concurrent with the sorting of the second mail item group into a second output receptacle set. Next, a third mail item group is introduced into the containers. Then, the second output receptacle set is emptied relatively concurrent with the sorting of the third mail item group into the (now empty and back into position) first output receptacle set. The process continues accordingly (page 10, line 20 – page 11, line 6).

In figure 5, a first mail item group is introduced into the containers. The first mail item group is then sorted into a first output receptacle group, relatively concurrent with the introduction of a second mail item group into the containers. Then, the first output receptacle

set is emptied relatively concurrent with the sorting of the second mail item group into a second output receptacle set and the introduction of a third mail item group into containers. The previous step is subsequently repeated for successive mail groups. For example, the second output receptacle set is emptied relatively concurrent with the sorting of the third mail item group into the (now empty and back into position) first output receptacle set and the fourth mail item group is introduced into the containers. The process continues accordingly (page 11, line 8 – page 14, line 13).

In figure 7, an initial mail item group is introduced into containers 1 and then sorted from containers 1 to containers 4. As containers 1 free up, a subsequent mail item group may be introduced therein. The initial mail group is then sorted from containers 4 into a first output receptacle set thereby freeing the way for the subsequent mail item group to be sorted from containers 1 into containers 4. This frees up containers 1 to receive yet another mail item group. The first output receptacle set (housing the initial mail group) is emptied as the subsequent mail item group is introduced into the second output receptacle set and the yet another mail item group is sorted from containers 1 to containers 4. The process continues accordingly (page 14, line 15 – page 15, line 19).

VI. ISSUES ON APPEAL

The issue on appeal is whether the Examiner established that Claims 19-27 are clearly anticipated under 35 U.S.C. §102(e) by United States Patent No. 6,227,378 B1.

VII. GROUPING OF CLAIMS

Based on the prior art of record, Applicants agree that Claims 19-27 stand or fall together.

VIII. ARGUMENT

Claims 19-27 stand finally rejected under 35 USC §102(e) as being clearly anticipated by United States Patent No., 6,227,378 B1 to Jones *et al.* (herein referred to as

Jones). In the Office Action Rejections, the Examiner does not provide an element by element comparison between the instant claims and Jones. Rather, in support of the Final Rejection and responsive to Applicants arguments, the Examiner notes that Jones discloses: that a “plurality of receptacles are designated as element 12 and their use described in column 3, lines 4+”; and “that the output receptacles are meant to collect mail into groups with different destinations”. The Examiner’s understanding of Jones as it relates to the present invention is inaccurate.

Jones discloses the following. Referring to Figure 1 and column 2, line 39 *et seq.*, an inlet area 8 introduces single or multiple mail pieces into one or more storage receptacles 4 which are carried about a carousel system 6 in a direction indicated by arrows within the figure (col. 2, lines 38-62). In an output area 10, mail pieces held in storage receptacles 4 and circulating about the carousel system 6 are made to drop into output receptacles 12 (col. 2, line 64 – col. 3, line 6). The output receptacles 12 are manually or automatically removable, an action facilitated by indicators 14 (col. 3, lines 7-14). A mail group is assigned to all of the output receptacle (col. 3, lines 32-39). Jones focuses on dynamically associating output receptacles and mail groups so as to control the times when the output receptacles are removed (col. 3, lines 64-67). The carousel system 6 acts as a buffer for storage receptacles 4. With the buffer, the Jones control system 16 can decide whether to deposit a mail item into an output receptacle – based on the items inclusion within a mail item group – or allow the item to circulate on the carousel or buffer (col. 4, lines 34-43). Accordingly, Jones waits until a sufficient number of mail pieces are present before depositing them into the output receptacle (col. 3, line 44 – 55).

The Jones operating environment is set out in column 4, line 55 *et seq.* Concerned with maximizing use of output receptacle space, Jones considers three criteria in defining a mail group: mail piece characteristic; operating environment; and system performance parameters (col. 4, lines 58-60). In addition, the operating environment is variable so that consideration and priority may be assigned to certain mail groups with the buffer handling groups of lower priority (col. 5, lines 18-26). Additionally, mail groups may be redefined to

not only to meet particular operating conditions but also to effect system performance. For example, when the system is stressed mail groups may be combined so that they can proceed to the next step of depositing into the output receptacles and visa versa (col. 5, lines 27-36). The aforementioned dynamic processes are effected by the control system 16 on an on-going operations basis (col. 5, lines 38-42).

As may be seen by comparing the Jones and instant invention discussions, certain fundamental differences are present. In the present invention:

- a) mail item "groups" are predefined and delineate how mail items are initially received;
- b) mail groups are sorted in sequence of mail item group receipt by delivery order;
- c) sorting throughput is effected via the division of output receptacles¹ into two sets; and
- d) focus is on increasing throughput.

In Jones, by comparison:

- a) mail item "groups" are not predefined;
 - mail item groups are dynamic and subject to change;
- b) mail items are not sorted by delivery order sequence because:
 - mail is received en-masse making sequential group handling impossible;
 - mail is sorted by output receptacle volume rather than destination address order;
- c) output receptacles are not divided into two substantially equal sets;
 - one mail item group² at a time is assigned to all of the output receptacles;
- d) focus is on maximizing use of output receptacle holding volume.

A claim is "anticipated" if comparison of the claimed invention with the prior art reference reveals that every element in the claim is shown or described, organized, and functioning in substantially the same manner as in the prior art reference. In re King, 801 F.2d 1324, 1326 (Fed. Cir. 1986). "A determination that a patent is invalid as being anticipated by 35 U.S.C. §102 requires a finding that 'each and every limitation is found

¹ and the containers in at least one embodiment.

² as defined by Jones, namely, "dynamic".

either expressly or inherently in a single prior art reference.' Celeritas Techs. Ltd. v. Rockwell Int'l Corp., 150 F.3d 1354, 1360, 47 USPQ2d, 1516, 1522 (Fed. Cir. 1998)." Transclean Corp. v. Bridgewood Services, Inc. 290 F.3d 1364, 62 USPTO2d 1865 (Fed. Cir. 2002). In accordance with Helifix Ltd. v. Blok Lok, Ltd., 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000): "The first step of an anticipation analysis is claim construction."; and "The second step in an anticipation analysis involves a comparison of the construed claim to the prior art. ... To be anticipating, a prior art reference must disclose 'each and every limitation of the claimed invention ...must be enabling and describe ... the claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.' In re Paulsen, 30 F.3d 1475, 1478, 79, 31 USPQ2d 1671 (Fed. Cir. 1994)." In rejecting the claims, the Examiner did not analyze the claim construction sufficiently to appreciate its scope. A comparison with prior art, based upon an insufficient claim construction, therefore fails to reach the proper conclusion that in fact each and every limitation of the claimed invention is not found in the prior art.

Instant claims 19 and 24 both recite:

... the depositing receptacles are subdivided into two more or less equally sized groups...

As detailed above, Jones does not divide his output receptacles into two or more equally sized groups, rather, Jones assigns a mail group to all of his output receptacles.

...in the case of organizing sorting runs proceeding one after the other...

Jones makes no attempt at organizing sorting runs proceeding one after the other. This is not possible for Jones because mail is not received 'pregrouped'. Rather, Jones groups the mail pieces after receipt and according to available space in his output receptacles. By this method, Jones is able to reduce the number of output receptacles needed – opposite to the present invention where a larger number of output receptacles to destination addresses are needed due to the instant fine sorting.

*...the items of mail of different address areas are alternately sorted only into one of the two
depositing-receptacle groups (emphasis added)*

Jones does not “alternately” sort only into one of the two receptacle groups. Rather, Jones’ dynamically defined mail item groups do not make alternate sorting a consideration.

IX. CONCLUSION

To sustain a 35 U.S.C. §102(e) clearly anticipated rejection, every element of the claimed invention must be clearly anticipated by the prior art reference. As set out above, the present invention finely sorts incoming mail item groups without interrupting throughput at least by dividing the output receptacles into at least two relative equal sets. Jones does not receive incoming mail groups, does not sort by destination address order, does not divide his output receptacles into at least two relatively equal sets, and does not address throughput.

The instant claims, as interpreted above and compared to the prior art reference, show no clear anticipation by Jones. Accordingly, the Examiner has not satisfied the requirements for a 35 USC §102(e) clearly anticipated rejection. Favorable reconsideration of the pending claims is respectfully solicited.

Respectfully Submitted,

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X. APPENDIX

19. (currently amended) An arrangement for organizing flat items of mail, in accordance with a definable sequence of delivery points assigned to recipient addresses, into a plurality of depositing receptacles into which in each case a plurality of items of mail can be destacked in organized fashion, having a reading arrangement for determining direct or indirect address information located on the items of mail separated by means of separating arrangement, having a plurality of containers which circulate on at least one conveying arrangement and are intended for receiving, for transporting and for discharging in a controllable manner in each case one item of mail into the depositing receptacles in a number of circulating cycles, and having a control arrangement which, with knowledge of the address information of all the items of mail located in the containers, controls the discharge of the items of mail from the containers to the depositing receptacles such that the sequence of the items of mail in a definable order of the depositing receptacles corresponds to the sequence of the delivery points assigned to the addresses, the order of the items of mail in each depositing receptacle corresponding to the sequence of the delivery points assigned to the addresses of the items of mail located in the respective depositing receptacle, characterized in that the depositing receptacles are arranged along the conveying arrangement, and in that the depositing receptacles are subdivided into two more or less equally sized groups and, in the case of organizing sorting runs proceeding one after the other, the items of mail of different address areas are alternately sorted only into one of the two depositing-receptacle groups.

20. (currently amended) The arrangement as claimed in claim 19, characterized in that the items of mail of a current address area can be loaded into empty circulating containers while items of mail of the preceding address area are still located in containers.

21. (currently amended) The arrangement as claimed in claim 20, characterized in that a loading location of the containers can be moved along the circulating containers in a controlled manner, within defined limits, such that the item of mail which is to be loaded in each case can be loaded into an empty container located in a defined movement range of the loading location.

22. (currently amended) The arrangement as claimed in claim 19, characterized in that, once non-sorted items of mail have been loaded into empty containers, pre-sorted items of mail a the same address area can be loaded into still empty containers or containers which are just becoming empty as a result of the non-sorted items of mail being discharged to the depositing receptacles, the delivery points being assigned place numbers in accordance with a mail defined order in the respective depositing receptacles, and the pre-sorting operation taking place such that the items of mail which are assigned to the delivery points with lower place numbers can be separated before the items of mail with higher assigned place numbers.

23. (currently amended) The arrangement as claimed in claim 22, characterized in that the non-sorted items of mail (3) of a current address area can be loaded into empty circulating containers (4) while items of mail (3) of a preceding address area are still located in containers (1).

24. (currently amended) A process for organizing flat items of mail, in accordance with a definable sequence of delivery points assigned to the recipient addresses, into a plurality of depositing receptacles into which in each case a plurality of items of mail are destacked in organized fashion, in the case of which direct or indirect address information located on the separated items of mail is read, in each case one item of mail is received into one of a plurality of containers circulating on at least one conveying arrangement, is transported therein and is discharged in a controlled manner into the depositing receptacles in a number

of circulating cycles, it being the case that, with knowledge of the address information of all the items of mail located in the containers, said items of mail are discharged from the containers to the depositing receptacles such that the sequence of the items of mail in a definable order of the depositing receptacles corresponds to the sequence of the delivery points assigned to the addresses, and it being the case that the order of the items mail in each depositing receptacle corresponds to the sequence of the delivery points assigned to the addresses of the items of mail located in the respective depositing receptacle, characterized in that the depositing receptacles are arranged along the conveying arrangement and are subdivided into two more or less equally sized groups and, in the case of organizing sorting runs proceeding one after the other, the items of mail of different address areas are alternately sorted only into one of two depositing-receptacle groups.

25. (currently amended) The process as claimed in claim 24, characterized in that the items of mail of a current address area are loaded into empty circulating containers while items of mail of a preceding address area are still located in containers.

26. (currently amended) The process as claimed in claim 24, characterized in that, once non-sorted items of mail have been loaded into empty containers, pre-sorted items of mail for a same address area are loaded into still empty containers or containers which are just becoming empty as a result of the non-sorted items of mail being discharged to the depositing receptacles, the delivery points being assigned place numbers in accordance with their defined order in the respective depositing receptacles, and the pre-sorting operation taking place such that the items of mail which are assigned to the delivery points with lower place numbers can be separated before the items of mail with higher assigned place numbers.

27. (currently amended) The process as claimed in claim 26, characterized in that the non-sorted items of mail of a current address area are loaded into empty circulating containers while items of mail of a preceding address area are still located in containers.